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SHAW PITTMAN
IP GROUP
1650 TYSONS BOULEVARD
SUITE 1300
MCLEAN, VA 22102

EXAMINER	
SING, SIMON P	

ART UNIT	PAPER NUMBER
2645	10

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/849,971	ROBERTS ET AL.	
	Examiner	Art Unit	
	Simon Sing	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 16 recites the limitation "the plurality of priority signals" in line 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-8, 11-18, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Epler et al. US Patent No. 5,825,867.

2.1 Regarding claim 1, Epler discloses a method of enhanced call waiting. Epler teaches:

associating a plurality of VIP (priority) codes with a called telephone number (column 11, lines 55-63), wherein each VIP code is a calling party identification (CPID) entered by a calling party, and each VIP code generates a different distinctive call

waiting tone (priority alert signal) at a called party's telephone to indicate the level of urgency or importance (priority level) (column 6, lines 13-28);

providing a VIP code to a calling party based on desired priority level (column 11, lines 55-63; column 6, lines 13-28);

receiving a telephone call from caller 12 while called party 10 is engaged in another call (column 4, lines 43-45);

receiving a VIP code from caller 12 (column 5, lines 32-36; column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a database (column 14, lines 16-30);

alerting the called party with a distinctive call waiting tone if a VIP code entered is valid (column 14, lines 16-30; column 5, lines 33-60);

connecting caller 12 to a voice messaging system if a VIP code entered does not match (column 14, lines 23-29); and

establishing communication between caller 12 and called party 10 if called party 10 so desires (column 1, lines 26-38).

2.2 Regarding claim 2, Epler teaches that the VIP code is unique to a caller (column 11, lines 55-63).

2.3 Regarding claim 4, Epler teaches that a priority alert signal is a regular call waiting tone (column 5, lines 56-60).

2.4 Regarding claims 5 and 6, Epler teaches prompting caller 12 to leave a message if no VIP code is entered, or a VIP code entered does not match (column 5, lines 39-42; column 14, lines 23-28).

2.5 Regarding claim 7, Epler discloses a method of enhanced call waiting. Epler teaches:

associating a plurality of VIP codes (priority codes) with a called telephone number (column 11, lines 55-63), wherein each VIP code is a calling party identification (CPID) entered by a calling party, and each VIP code generates a different distinctive call waiting tone (priority alert signal) at a called party's telephone to indicate the level of urgency or importance (priority level) (column 6, lines 13-28);

assigning a priority level alert signal to each of the plurality of VIP codes (column 6, lines 13-28);

providing a VIP code to a calling party based on a desired priority level for the calling party (column 11, lines 55-63; column 6, lines 13-28);

receiving a telephone call from caller 12 while called party 10 is engaged in another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36; column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a database (column 14, lines 16-30);

alerting the called party with a distinctive call waiting tone if a VIP code entered is valid (column 14, lines 16-30; column 5, lines 33-60);

connecting caller 12 to a voice messaging system if the VIP code entered does not match (column 14, lines 23-29); and

establishing communication between caller 12 and called party 10 if called party 10 so desires (column 1, lines 26-38).

2.6 Regarding claim 8, Epler teaches that each VIP code represent a different caller (column 11, lines 55-563, column 6, lines 13-28).

2.7 Regarding claim 11, Epler discloses a system of enhanced call waiting in figure 1, comprising:

a switch 20 in communication with a telephone line (column 3, lines 17-23), wherein the switch is configured to detect incoming calls intended for user 10 who is already engaged in a first communication with another caller (column 4, lines 43-45);

a processor (computer 56) in communication with the switch, wherein the processor is configured to review information associated with user 10 (column 3, lines 33-36; column 4, lines 37-55) to determine whether user 10 is a subscriber of the enhanced call waiting subscriber (column 5, lines 32-35);

wherein the processor receives a query from the switch and identifies that user 10 is a subscriber of the system, then instruct the switch to solicit a VIP code from caller 12 (column 5, lines 35-39; column 14, lines 16-30);

wherein the processor instructs the switch to interrupt the first communication with a priority alert signal if the VIP code provided by caller 12 matches one of a plurality of VIP codes stored in database 55, wherein each of the plurality VIP code is a calling party identification (CPID) entered by a calling party, and is further associated with a different distinctive call waiting tone (priority alert signal) at a called party's telephone to indicate the level of urgency or importance (priority level) (column 5, lines 42-54; column 6, lines 13-28); and

wherein the switch establishes communication between caller 12 and user 10 if user 10 so desires (column 1, lines 26-38).

2.8 Regarding claim 12, switch 20 is provisioned with a trigger for cause a call waiting lone (column 5, lines 56-60).

2.9 Regarding claim 13, Epler teaches a 5ESS switch at a central office (column 5, lines 47-50). Since 5ESS is an advanced intelligent network and inherently, a 5ESS switch is a SSP.

2.10 Regarding claim 14, Epler teaches that a priority alert signal is a regular call waiting tone (column 5, lines 56-60).

2.11 Regarding claim 15, Epler discloses a method of enhanced call waiting. Epler teaches:

associating two or more VIP (priority) codes with a called telephone number (column 11, lines 55-63), wherein each VIP code is a calling party identification (CPID) entered by a calling party, and each VIP code generates a different distinctive call waiting tone (priority alert signal) at a called party's telephone to indicate the level of urgency or importance (priority level) (column 6, lines 13-28);

providing a VIP code to a calling party based on a desired priority level for the calling party (column 11, lines 55-63; column 6, lines 13-28);

receiving a telephone call from caller 12 while called party 10 is engaged in another call with another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36; column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a database(column 14, lines 16-30);

alerting the called party with a distinctive call waiting tone for indication the urgency or importance of the telephone call, if the VIP code entered is valid (column 5, lines 33-60; column 6, lines 13-28); and

establishing communication between caller 12 and called party 10 if called party 10 so desires (column 1, lines 26-38).

2.12 Regarding claim 16, Epler teaches that each VIP code represent a different caller (column 11, lines 55-563, column 6, lines 13-28).

2.13 Regarding claim 17, Epler teaches that each distinctive call waiting tone represents a different level of priority or urgency (column 6, lines 13-28).

2.14 Regarding claim 18, Eplaer teaches each VIP code is unique to the calling party (column 11, lines 55-63).

2.15 Regarding claim 20, Epler discloses a method of enhanced call waiting. Epler teaches:

associating a plurality of VIP (priority) codes with a called telephone number (column 11, lines 55-63), wherein each VIP code is a calling party identification (CPID) entered by a calling party, and each VIP code generates a different distinctive call waiting tone (priority alert signal) at a called party's telephone to indicate the level of urgency or importance (priority level) (column 6, lines 13-28);

assigning a different distinctive call waiting tone to each VIP code (CPID) (column 6, lines 13-28);

providing a VIP code to a calling party based on a desired priority level for the calling party (column 11, lines 55-63; column 6, lines 13-28);

receiving a telephone call from caller 12 while called party 10 is engaged in another call with another call (column 4, lines 43-45);

prompting and receiving a VIP code from caller 12 (column 5, lines 32-36; column 14, lines 16-30);

determining whether the VIP code received matches a VIP code stored in a database(column 14, lines 16-30);

alerting the called party with a distinctive call waiting tone for indication the urgency or importance of the telephone call, if the VIP code entered is valid (column 5, lines 33-60; column 6, lines 13-28); and

establishing communication between caller 12 and called party 10 if called party 10 so desires (column 1, lines 26-38).

2.16 Regarding claim 21, Epler teaches that each VIP code is unique to a calling party (column 11, lines 55-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 9, 10, 19, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elper et al. US 5,825,867 in view of Groen et al. US 6,650,746.

Epler teaches prompting a calling party to enter a VIP code in call waiting, and generating a distinctive alert signal in accordance with the VIP code. Epler fails to teach providing the caller with two or more codes, each code associated with a priority level.

However, Groen discloses an urgency call indication to a called party through distinctive notification in figure 1. Groen teaches that a caller may enter more than one urgency level indicator (priority code) to generating a distinctive ring pattern in accordance with the entered indicator (Abstract, column 3, 28-32, 46-54; column 4, lines 8-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Epler's reference with the teaching of Groen, so that a calling party would have been given two or more VIP (priority) code, each associated with a distinctive call waiting (alerting) tone for indicting the level of priority, because such a modification would have given a called party more informed information regarding the urgency of an incoming call.

Response to Arguments

4. Applicant's arguments filed 02/05/2004 have been fully considered but they are not persuasive.

The applicant argues that Epler does not teach setting priority codes associated with given priority levels (See last paragraph of page in the Remark). As stated in the rejection above, Epler teaches that VIP codes are assigned to different calling parties as calling parties' identifications (column 11, lines 55-63). Epler also teaches that a distinctive call waiting tone is associated with a calling party's identification (CPID), derived from information inputted by a calling party (column 6, lines 13-28). Epler further teaches that a calling party enters his VIP code to identifying himself (column 14,

lines 16-30) in call waiting. Thus each distinctive call waiting tone is associated with a VIP code given to a calling party by the subscriber, and therefore, Epler teaches the claimed subject matter in claims 1, 7, 11, 15 and 20.

Conclusion

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

S.S.

07/02/2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600